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EXAMINER

HOFFMAN, MARY C

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3733

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12, 15, 18, 21-23, 25-31 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Shih et al. (US 6,136,002).

Shih et al. disclose a device for treating spinal deformities, comprising a spinal anchoring element (see ref. #10, FIGS. 2-3) adapted to seat first (FIG. 2, ref. #40, right) and second (FIG. 2, ref. #40, left) spinal fixation elements at a distance spaced apart from one another; a bore (ref. #124) and a closure mechanism (ref. #14) adapted to mate to the spinal anchoring element to lock each of the first and second spinal fixation elements in a fixed position relative to the spinal anchoring element. The spinal anchoring element a fastening element (ref. B.) and includes a first recess (ref. #126, right) adapted to receive a first spinal fixation element, and a second recess (ref. #126, left) spaced a distance apart from the first recess and adapted to receive a second spinal fixation element. The closure mechanism is capable of receiving a locking mechanism that engages the bore (note: “engages” does not require direct contact; moreover; this claim recitation is being interpreted as functional language, and the Shih et al. reference need merely be capable of performing the claimed function). The spinal

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anchoring element includes a central portion (ref. #130) positioned between the first and second recesses and {adapted to receive a fastening element for mating the anchoring element to bone- functional language}. The central portion includes a bore (ref. "H") extending therethrough {for receiving a fastening element- functional language}. The closure mechanism includes a central portion (see hole in ref. #14) adapted to receive a locking mechanism for mating the closure mechanism to the spinal anchoring element. The device further comprises a fastening element (ref. "B") for mating the spinal anchoring element to bone, and a locking mechanism (ref. "S") for mating the closure mechanism to the spinal anchoring element. The fastening element comprises a bone screw, and the locking mechanism comprises a setscrew. The first recess is formed in a first end portion of the spinal anchoring element and the second recess is formed in a second, opposed end portion of the spinal anchoring element. Each end portion includes a superior surface and an inferior surface, the first and second recesses being formed in the superior surface. The device further comprises a bone-engaging member, a spike (ref. #122), extending distally from the inferior surface of each of the first and second end portions adapted to extend into bone to prevent rotation of the spinal anchoring element. The closure mechanism includes a first end portion adapted to lock a spinal fixation element within the first recess, and a second end portion adapted to lock a spinal fixation element within the second recess. The device further comprises first and second spinal fixation elements (ref. #'s 40) adapted to be disposed between the spinal anchoring element and the closure mechanism. Each recess has a substantially concave shape. A plurality of spinal anchoring devices adapted to mate to

a plurality of vertebrae and to engage the first and second spinal fixation elements such that the first and second spinal fixation elements can be tensioned between the plurality of spinal anchoring devices to adjust a position of the plurality of vertebrae in both a sagittal plane and a coronal plane when the plurality of spinal anchoring devices are implanted in a plurality of vertebrae. The system further comprises a bore extending through the closure mechanism and spinal anchoring element {for receiving a fastening element adapted to mate the spinal anchoring element to bone- functional language}. The bore in the closure mechanism and spinal anchoring element is positioned between the first and second recesses.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-17 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shih et al. (US 6,136,002) in view of Paul et al. (US 2004/0236327).

Shih et al. disclose the claimed invention except for each spinal fixation element being flexible and being formed from a bioabsorbable material.

Paul et al. disclose spinal fixation element being flexible and being formed from a bioabsorbable material (paragraph [0097]) to provide an improved spinal fixation element.

It would have been obvious at the time the invention was made to construct the fixation elements of Shih et al. being flexible and bioabsorbable in view of Paul et al. to provide a spinal improved fixation element.

Response to Arguments

Applicant's arguments filed 02/07/2008 have been fully considered but they are not persuasive. Applicant argues that the Shih et al reference does not anticipate or suggest the amended claim language. It is noted that the term “engages” does not require direct contact; moreover; this claim recitation is being interpreted as functional language, and the Shih et al. reference need merely be capable of performing the claimed function. With regard to the statements of intended use and other functional statements, i.e. “adapted to” recitations in the claims and see “{functional language}” in above explanation, they do not impose any structural limitations on the claims distinguishable over Shih et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The rejections are deemed proper.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MARY HOFFMAN** whose telephone number is (571)272-5566. The examiner can normally be reached on Monday-Thursday 10:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Mary C. Hoffman/
Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733